

The Rejection Under 35 U.S.C. § 103

All claims were rejected as assertedly obvious over the combination of a multiplicity of documents all of which are said to teach the ingredients in the claimed composition as ingredients in detergent compositions. Applicants respectfully assert that the combination of documents cited by the Office does not render the claimed composition obvious for at least two reasons.

First, the Office has pointed to nothing in the prior art which would teach the artisan that the combination of these ingredients should be diluted into a microemulsion which is clear enough to have a turbidity of <3 NTU.

Second, there is nothing in the prior art cited by the Office which suggests that the ingredients of the claimed composition taken alone or together, when so diluted, have a pesticidal effect. For these two reasons, at least, the rejection should be withdrawn.

With respect to the failure of the art to suggest the dilution of the complex formed by the listed ingredients to a clear microemulsion of <3 NTU, the Office states that “there is nothing in the body of applicants’ claims which states that the microemulsion is clear and aqueous only in the preamble.” As noted in the phone interview, the body of the claim does contain the limitation of clarity because the microemulsion is required to have a turbidity <3 NTU.

With respect to the requirement that the microemulsion be aqueous, it is believed that this limitation is incorporated into the body of the claim by reference to the word “microemulsion” in the preamble in the body of the claim. If the Office would prefer, the word “aqueous” may be inserted into the claim prior to “microemulsion” in the last phrase.

With respect to the assertion that the combination of ingredients in the complex is rendered obvious by virtue of the shared purpose of each of them in the art, thereby suggesting their combination, the Office takes the position that the fact that the resulting combination is

pesticidal is irrelevant. The Office takes the position that it is “*prima facie* obvious to combine two or more ingredients each of which is taught by the prior art to be useful for the same purpose in order to form a third composition which is useful for the same purpose.” As applicants understand from the interview, the Office takes the position that since all of the ingredients have been disclosed as useful as cleaning/detergent compositions, the skilled artisan would be motivated to combine them, and the fact that the resulting composition results in the unexpected property of having a pesticidal effect does not confer patentability. The Office has cited four cases in support of this proposition.

In view of this Office action, applicants have reviewed the cited cases, and are unable to find any holding in support of the position taken by the Office in this case. Copies of the relevant decisions are enclosed for the convenience of the Examiner.

The first case, *In re Sussman*, which is cited as 1943 C.D. 518 and which applicants believe is the attached case reported in 58 USPQ 262 (CCPA 1943) concerns claims for a “pre-tonsorial preparation for application to the skin before shaving to impart relative rigidity to the hairs.” The claims were found unpatentable over documents that disclosed the ingredients of the composition. However, all of the ingredients that were included in the claim were previously used in shaving compositions or for the purposes that they actually served in the claimed subject matter. As the Court summed up in the next to penultimate paragraph, it is of the opinion

that each of the ingredients in appellants’ preparation, as disclosed by the prior art cited, has well known properties, and that the combining of these ingredients in appellants’ preparation produce no unexpected results. On the contrary, each of those ingredients functions in appellants’ precisely as was to be expected from the teachings of the cited prior art.

Clearly this is not the basis for rejection here where the ingredients are disclosed in the cited prior art as detergent/cleaning compositions whereas the combination results in a pesticidal composition.

The next case cited was *In re Pinten, et al.*, 173 USPQ 801 (CCPA 1972) which concerned only method claims. There appear to be no composition claims under consideration. The method claims were directed to improvements in a process for production of foam plastic by using certain surface active agents. The claims related to mixtures of surfactants, claims 5 and 6, were considered obvious because the individual components were previously used for the purpose to which they were dedicated in the claim.

By way of incidental comment, claims 16-20 which specified particular ratios used to control the volume of the foam cells (sort of a new use) were considered patentable.

The next case cited is *In re Susi*, 169 USPQ 423 (CCPA 1970) where the composition claims were directed to a polymer in combination with a compound which is a member of a specific genus. Again, the combination was used for the same purpose for which the combination was disclosed to be used in the prior art. Apparently, the claimed composition was to be used to protect polystyrene from ultraviolet light and one ingredient of the composition was used for that purpose in the prior art and the other was similar to a compound that was used for that purpose in the prior art.

Thus, again, the purpose to be served by the composition is identical to the purpose to be served by the ingredients in the prior art.

Finally, the Office cites *In re Crockett, et al.*, 126 USPQ 186 (CCPA 1960). There was only one composition claim in this case which was directed to a treating material for injection into cast iron. The composition was a mixture of calcium carbide and magnesium oxides or rare

earth oxides. The other claims were process claims. Again, each of the calcium carbide and magnesium oxide were disclosed for this very same purpose as that set forth in the claim in the prior art.

In summary, none of the cases cited by the Office, when actually read, supports the position that the pesticidal properties of the composition claimed are irrelevant to patentability.

Applicants believe that the controlling case in this area is *In re Papesch*, 315 F2d 381, 137 USPQ 43 (CCPA 1963) and a copy is enclosed for the convenience of the Examiner. The claims in that case were directed to compounds (analogous to compositions) where the compounds were very similar to compounds disclosed in the prior art but not as anti-inflammatory compounds. The Court cited a large number of cases in support of its conclusion that the compounds are patentable in light of the previously undisclosed anti-inflammatory property of the invention compounds. What the Court said on page 51 is:

Returning now, to the decision of the Board in this case, we think that it rests on a fundamental error of law, namely the failure to take into consideration the biological or pharmaceutical property of the compounds as anti-inflammatory agents on the ground that to chemists the structure of the compounds would be so obvious as to be beyond doubt and that a showing of such properties is to be used only to resolve doubt.

From the standpoint of patent law, a compound and all of its properties are inseparable; they are one and the same thing....There is no basis in law for ignoring any property in making such a comparison and assume similarity based on a comparison of formulae must give way to evidence that the assumption is erroneous.

This case is frequently cited for precisely this proposition. A new and unexpected property of a composition must be taken into account in considering patentability decisions.

Thus, here, in view of the novelty of the composition itself and the failure of the cited art to suggest that the components of the composition have pesticidal properties, the discovery of such properties of the composition clearly confers patentability.

In view of the foregoing, the rejection over the art may properly be withdrawn.

CONCLUSION

The asserted lack of clarity in the claims has been addressed. The rejection over the art is believed in error as there is no showing that any of the art teaches the claim limitation of a clear aqueous microemulsion with a turbidity <3 NTU. In addition, applicants believe the rejection over the art is in error as it fails to consider the pesticidal properties of the claimed composition which, in line with the holding of *In re Papesch*, must be considered. Accordingly, it is believed that all pending claims are in a position for allowance and passage of these claims to issue is respectfully requested.

Should any minor issues remain outstanding, a telephone call to the undersigned is respectfully requested.

In the unlikely event that the transmittal letter is separated from this document and the Patent Office determines that an extension and/or other relief is required, applicants petition for any required relief including extensions of time and authorize the Assistant Commissioner to charge the cost of such petitions and/or other fees due in connection with the filing of this document to **Deposit Account No. 03-1952** referencing docket No. 437472000200.

Respectfully submitted,

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